

### REMARKS

Claims 157, 164-168, 174-180, and 182-208 have been cancelled without prejudice. Claims 158 and 181 have been amended. New claims 209-213 have been added. Thus, claims 158, 169-173, 181, and 209-213 are pending in the present application.

### Telephone Interview

The Applicants express their appreciation to Examiner Shapiro for talking the time to conduct a telephone interview for the present case on May 8, 2003 with the Applicants undersigned representative. The present amendment reflects the Examiner's suggestions discussed during that telephone interview. Thus, the pending claims are believed to be allowable.

### Claims Rejections – 35 U.S.C. § 102 (Hashimoto)

Claims 157, 158, 168-173, 181, 190, and 204 have been rejected as being anticipated under 35 U.S.C. § 102(a) by U.S. Patent No. 4,653,647 to Hashimoto. The Applicants respectfully traverse these rejections. However, in order to expedite the prosecution of the present application, the Applicants have amended independent claims 158 and 181 as suggested by the Examiner during the telephone interview. The Applicants have cancelled claims 157, 190, and 204 without prejudice and, therefore, will not further address these claims.

In response to the remarks set forth in the Applicants previous reply, the Office Action, ¶8, states that "Hashimoto . . . discloses a system having the components to effectuate the action described in Applicants' claims." The Applicants respectfully traverse this characterization of Hashimoto. The Applicants further respectfully submit that this is not the standard for anticipation under 35 U.S.C. § 102(a). "A claim is anticipated only if each and every element as set forth in the claim is found . . . in a single prior art reference." M.P.E.P. § 2131 (emphasis added).

Turning to the Applicants' claims, independent claims 158 and 181 are generally directed to a currency evaluation device that includes an interface for inputting a user-defined mode and a memory having stored therein modes of operation and at least one user-defined mode of operation specifying how error conditions are handled by the device. Specifically, the Applicants' independent claim 158 requires:

(i) “. . . a memory adapted to store information associated with a plurality of modes of operation of the device, the memory being designed to store at least one-user defined mode . . . capable of subsequent recall and selection by a user . . .;” and

(ii) “an interface adapted to permit a user of the evaluation device to define the user-defined mode of operation, the interface receiving information from the user specifying how the device is to operate . . ., the information being stored in the memory . . . .”

Similarly, the Applicants’ independent claims 181 recites:

(i) “a nonvolatile memory adapted to store information associated with a plurality of pre-defined modes of operation of the device, the memory being adapted to store at least one user-defined mode of operation in a manner such that the at least one user-defined mode of operation is capable of subsequent recall and selection by a user of the evaluation device;”

(ii) an interface adapted to permit a user of the evaluation device to define the user-defined mode of operation, the interface being adapted to receive information from the user specifying criteria for evaluating the bills and specifying to which of output receptacles a bill meeting or failing to meet one or more criteria is to be transported, the information being stored in the nonvolatile memory as a user-defined mode of operation; . . . .”

As explained in the following paragraphs, the Applicants’ claims 158 and 181 are patentable over Hashimoto under 35 U.S.C. § 102(a) for at least the reason that Hashimoto does not disclose a memory and an interface having the above-recited claimed features.

First, the Applicants’ claims 158 and 181 both require a plurality of modes of operation stored in the memory and a distinct user-defined mode of operation stored in the memory. The only modes for operating the Hashimoto sorting and stacking apparatus are factory defined modes (a)-(g) listed in Table I of Hashimoto. These are “factory-defined” modes of operation meaning that they are pre-defined modes of operation stored in a memory of the device. Hashimoto does not disclose operating the sorting and stacking apparatus pursuant to any user-defined modes.

Second, the Applicants’ claims 158 and 181 both require an interface that allows the user to input information specifying how the device is to operate, wherein that information is stored in memory as a user-defined mode of operation that can be recalled and selected at a later time. Thus, a user of the currency evaluation device of claims 158 and 181 can input the information defining a user-defined mode and then select that information at a later time obviating the need to reenter the same information. The only user input that the Hashimoto sorting and stacking apparatus is capable of receiving is the selection of a mode of operation

that has been previously stored in a memory of the Hashimoto apparatus. Hashimoto does not disclose that a user can input information specifying how the device is to operate wherein the input information is then stored in memory. Again, Hashimoto only discloses that a user can select a mode of operation already stored in memory.

The office action makes a conclusory statement that Hashimoto discloses “a memory (33), capable of storing user information.” The Applicants traverse this characterization of Hashimoto. Hashimoto does not disclose a memory that stores information received from a user as required by the Applicants’ claims.

The Office Action, ¶3, concludes by noting “the elements of Hashimoto are adapted to perform the functions and limitations of Applicants’ independent claims.” Again, as the Applicants stated above, this is not the proper standard for anticipation. Each and every limitation of the Applicants’ claims must be disclosed by Hashimoto for there to be anticipation. Hashimoto does not disclose each and every element of the Applicants’ claims 158 and 181.

Thus, the Applicants respectfully submit that claims 158 and 181, and the claims that depend therefrom, are patentable over Hashimoto under 35 U.S.C. § 102(a) for at least the above-discussed reasons.

#### Claims Rejections – 35 U.S.C. § 103 (Hashimoto)

Claims 191, 192, 196, and 205-208 have been rejected as being unpatentable under 35 U.S.C. § 103(a) over Hashimoto. The Applicants respectfully traverse these rejections. These claims, however, have been cancelled without prejudice. Thus, it is respectfully submitted that the rejection of claims 191, 192, 196, and 205-208 is moot.

#### Claims Rejections – 35 U.S.C. § 103 (Hashimoto & Minami)

Claims 197-200 have been rejected as being unpatentable under 35 U.S.C. § 103(a) over Hashimoto in view of U.S. Patent No. 4,991,833 to Minami et al. The Applicants respectfully traverse these rejections. These claims, however, have been cancelled without prejudice. Thus, it is respectfully submitted that the rejection of claims 197-200 is moot.

#### Claims Rejections – 35 U.S.C. § 103 (Hashimoto & Cargill)

Claims 164-167 have been rejected as being unpatentable under 35 U.S.C. § 103(a) over Hashimoto in view of U.S. Patent No. 5,430,664 to Cargill et al. The Applicants

respectfully traverse these rejections. These claims, however, have been cancelled without prejudice. Thus, it is respectfully submitted that the rejection of claims 164-167 is moot.

Claims Rejections – 35 U.S.C. § 103 (Omatu & Molbak)

Claims 157, 158, and 164-167 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,729,623 to Omatu et al. in view of U.S. Patent No. 5,564,546 to Molbak et al. Applicants respectfully traverse this rejection. Claims 157 and 165-167 have been cancelled without prejudice and will therefore not be discussed in this Reply.

The Applicant's claim 158 includes limitations directed to receiving and storing a user-defined more of operation for handling error conditions as is set forth above. Omatu does not disclose that occurrences of error conditions can be handled as specified by a user or in a user-defined manner or that the user specifications or user-defined manner can be stored in a memory; rather, Omatu only mentions that bills that cannot be identified are routed to a reject stacker 106. See Omatu at col. 16, ll. 58-61. Molbak does not disclose the processing or currency bills or the handling of error conditions in a user-defined manner.

The combination of cited references simply does not disclose, teach, or suggest all of the elements of the Applicant's independent claim 158. Thus, the Applicants respectfully submit that claim 158 is patentable over Omatu in view of Molbak under 35 U.S.C. § 103(a).

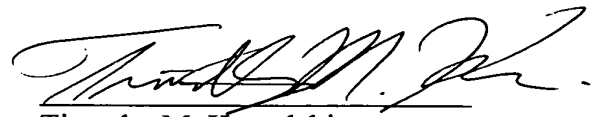
Conclusion

In conclusion, the Applicants respectfully submit that in view of the amendments and remarks set forth herein, that all rejections have been overcome and that all claims are in condition for allowance and such action is earnestly solicited.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicants' undersigned attorney at the number indicated.

It is believed that no fee is due in connection with this Amendment and Reply. However, a Request for Continued Examination (RCE) is being filed concurrently herewith. A check to cover the fee for filing the RCE is enclosed. If, however, there are additional fees due, the Commissioner is authorized to charge any additional fees which may be required (except the issue fee) to JENKENS & GILCHRIST, P.C. Deposit Account No. 10-0447(47171-00272USC1).

Respectfully submitted,



Timothy M. Kowalski

Reg. No. 44,192

**JENKENS & GILCHRIST, P.C.**

225 West Washington Street, Suite 2600

Chicago, IL 60606-3418

(312) 425-8518

(312) 425-3909 (fax)

Date: May 22, 2003

ATTORNEYS FOR APPLICANTS